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In re Application of:)	Group Art Unit: 3616
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EXHIBIT A

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NON-STATUTORY DOUBLE PATENTING

EXAMPLE I: This example deals with non-statutory double patenting that is of the obvious type (one-way test)

EXAMPLE II: This example also deals with non-statutory double patenting that is of the obvious type (one-way)

EXAMPLE III: This example deals with when its appropriate and under what conditions a two-way analysis for double patenting is appropriate. (In re Bratt)

EXAMPLE IV: This example further explores the conditions under which a one-way or two-way test is applied. (In re Goodman)

EXAMPLE V: This example deals with a non-obvious type/non-statutory double patenting (In re Schneller).

EXAMPLE VI: This example deals with a double patenting situation wherein a function from a means clause is omitted from the claim in issue.

EXAMPLE VII: This example deals with an obviousness type double patenting situation wherein an element and its function is omitted from the claim in issue.

In all of the examples above, it is assumed that the application is filed by

- (1) The same inventive entity
- (2) different inventive entities having a common inventor

or

(3) a common assignee

EXAMPLE I

This example deals with non-statutory double patenting that is of the obvious type (one-way test).

FACT SITUATION

The effective filing date of the application is after that of the patent. The earlier filed patent discloses a basketball backboard in combination with a basketball hoop and claims such. The subject matter of the application is an improvement or modification invented after the filing the patent. The improvement being the backboard having means to provide flashing lights so as to visually announce with some "fanfare" the passage of a basketball through the hoop. The prior art teaches the use of flashing lights on backboards for the same reasons advanced in the application.

DISCUSSION

This is a case of an improvement or modification after filing. Hence it is the usual "obviousness-type" double patenting case. Since the effective date of the application is after that of the patent, only a "one-way" patentability determination in determining "obviousness-type" double patenting be applied.

Once it's determined that the "same invention" is not being claimed twice, a "second analysis" question must then be asked.

Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?

If the answer is yes, generally "obvious-type" double

patenting exists and the claim is not allowable in the absence of a terminal disclaimer.

In making an "obvious-type" double patenting rejection, the rejection should be clear as to the difference or differences between the inventions defined by the conflicting claims.

In this example, the differences being the use of flashing lights on the backboard to visually indicate the scoring of a basket.

The rejection should supply the rationale to support the conclusion of obviousness.

If the effective filing date of the application was the same as the patent, a one-way test would still be employed for the reasons advanced above.

EXAMPLE II

The example deals with non-statutory patenting that is of the obvious type (one-way test).

FACT SITUATION

The effective filing date of the application is after that of the patent. The earlier filed patent discloses a method of producing a specific polymerization catalyst by mixing an organometallic compound of a metal belonging to Groups I to III inclusive of the Mendelyeen Periodic system with fullerene precursors. The patent claims such a method. The subject matter of the application is an improvement or modification invented after filing of the patent. The improvement being the discovery that the formation of the polymerization catalyst occurs fairly easily when the mixture is heated between 50° C and 75° C. The prior art teaches that the use of heat in forming similar catalytic compositions is old for the same reasons advanced by applicant.

DISCUSSION

This is a case of an improvement or modification after filing. Hence it is the usual "obviousness-type" double patenting case. Since the effective date of the application is after that of the patent, only a "one-way" obviousness determination is made to determine "obvious-type" double patenting.

Once it is determined that the "same invention" is not being claimed twice, a second question must then be asked.

Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?

If the answer is yes, generally "obvious-type" double patenting exists and the claim is not allowable in the absence of a terminal disclaimer.

In making an "obvious-type" double patenting rejection, the rejection should be clear as to the difference or differences between the inventions defined by the conflicting claims and the reasons to support the conclusion of obviousness.

In this example the difference being the use of heat to drive the reaction.

The rejection should supply the rationale to support any conclusion of obviousness and where applicable a discussion of expectation of success should be set forth.

If the effective filing date of the application was the same as the patent, a one-way test would still be employed for the reasons advanced above.

EXAMPLE III

This Example deals with the application of a two-way obviousness test and the condition of that test.

If the patent is the later filed case, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed.

FACT SITUATION

In an earlier filed application a claim drawn to a device reads as follows:

Application Claim 1: A device comprising A_{Broad} + B_{Broad}

In a later filed application that has become a patent a claim is drawn that reads as follows:

Patent Claim 1: A device comprising A_{Broad} + B_{Specific}

Secondary teachings in the art clearly teach that the B_{Specific} is a well known embodiment of B_{Broad}

Through no fault of the applicant, the earlier filed case was not examined as quickly as the later filed case.

DISCUSSION

Because of the delay - the later filed case issued first, should a one way or two way obviousness analysis be employed.

Since the delay was not caused by the applicant, a two way test must be applied to determine double patenting. Because the applicant does not have complete control over the rate of progress of a patent application through the Office, the delay in this case was not caused by the applicant. In this case, PTO action (or lack of action) dictated the rate of prosecution.

This type of delay is an "administrative delay". In such cases a two way determination is appropriate. Thus, it is necessary to apply the Graham obviousness analysis twice - once with the application claims as the claim in issue, and once with the patent claims as the claims at issue. Where a two-way obviousness determination is required, an obviousness type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims at issue in an obvious variation of the invention defined in a claim in the other patent.

EXAMPLE IV

This Example further explores conditions for applying a one-way or two-way analysis (In re Goodman).

FACT SITUATION

Applicant in a first filed case presents 2 claims of varying scope to a similar device. The broad claim calls for A_{broad} . The narrower claim calls for $A_{specific}$.

Upon receiving a first Office action which rejected the broad claim and allowed the narrower claim, applicant voluntarily filed a continuation. Applicant cancelled the broad claim, let the first application pass to issue with the narrow claim, and prosecuted the broad claim in a continuation. The examiner has made a non-statutory double patenting rejection based in the principle that without a terminal disclaimer, the patented species claims precludes the issuance of the generic application. (In re Goodman). The examiner argues:

- 1) The subject matter claimed in the application was fully disclosed in the earlier filed application;
- 2) The patent protection already granted in the earlier filed case would be extended by the allowance of the claim in the later filed application; and
- 3) There is no apparent reason why applicant was prevented from fully prosecuting the broad claim in the parent.

DISCUSSION

Should a one-way or two-way analysis be applied?

A two-way analysis would only be applicable if there was

"Administrative delay". In this example, the actions of the PTO did not dictate the rate of prosecution. Applicant chose to file a continuation and seek early issuance of the narrower claim. Applicant's recourse was not solely limited to filing a continuation. As stated in In re Goodman in a similar situation, applicant could have filed an appeal to the C.A.F.C. but in the absence of such, no "Administrative delay" was present and a one-way test was all that was needed in establishing a non-statutory double patenting rejection. By adopting the course of filing a continuation or voluntary divisional application to obtain a broader claim, the patentee could unjustly gain an extension of the patent term of the narrower claim upon the later issuance of the broad claims.

EXAMPLE V

This example deals with non-statutory double patenting that also is non-obvious (In re Schneller).

FACT SITUATION

An earlier filed patent specifically discloses a device comprising a combination of a variety elements (A, B, C, X, and Y) wherein there are three disclosed embodiments

- (1) A B C X
- (2) A B C Y
- (3) A B C X Y

The claim in this patent reads as follows:

Patent Claim 1: A device comprising the combination of elements A, B, C, and X.

A later filed copending patent application has a claim that reads as follows:

Application Claim 1: A device comprising the combination of elements A, B, C, and Y.

This application claim was never earlier presented. The combination ABCY is not considered obvious over the combination ABCX.

DISCUSSION

This is not a case of an improvement or modification invented after filing. Applicant in the application is claiming an embodiment disclosed but never claimed in the patent - an option exercised by applicant, not as a result of a restriction requirement.

The rule against double patenting seeks to prevent the unjustified extension of the right to exclude granted by a patent beyond the 17 year term of a patent.

Thus, the question to be answered in this Example is whether or not the subject matter covered by the claim of the patent would have its 17 year term extended if the claim in the application is patented.

The double patenting determination involves two inquiries. First, is the same invention claimed twice (35 USC 101)?

Clearly, the answer is no.

As stated above, the invention claimed in the application is not considered obvious over the invention claimed in the patent. In making the analysis for non-statutory double patenting when it is of the non-obviousness variety, the First Question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no - double patenting does not exist.

If the answer is yes, the Second Question is: Is there any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no - a double patenting rejection is appropriate.

Applying this analysis, we find the answer to Question 1 to be yes.

The answer is yes because the transitional phrase "comprising" does not exclude the presence of elements other than A, B, C, X in the claim. Because of the phrase "comprising" the

patent claims not only provides protection to ABCX but also extends patent coverage to the disclosed combination - ABCXY. Likewise, if allowed, the claim of the application, because of the phrase "comprising", not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY - already disclosed and covered by the claim in the patent. Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claim in the application.

Since no reason is seen why applicant did not present the claim to ABCY, a double patenting rejection is appropriate.

Would double patenting exist if the patent claim read "... consisting of ... A, B, C, and X".

No. The "consisting" type language would not extend coverage to ABCXY or ABCY. Consisting is a transitional phrase which limits the scope of the claim to only those elements set forth in the claim.

PROPOSED FORM PARAGRAPH STATEMENT PRIOR TO A D.P. REJECTION

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA

1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

PROPOSED REJECTION IN SCHNELLER CASE

Claim 1 is rejected under the judicially created doctrine of double patenting.

The subject matter recited in claim 1 of the patent application - "comprising ABCY" - is fully disclosed in the patent. The allowance of this claim would extend the rights to exclude already granted in claim 1 of the patent - that right to exclude covering the device "comprising ABCX". The transitional phrase "comprising" does not exclude the presence of elements other than A, B, C, X in the claim. Because of the phrase "comprising" the patent claim not only provides protection to ABCX but also extends patent coverage to the disclosed combination - ABCXY. Likewise, if allowed, the claim of the application, because of the phrase comprising, not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY -

already disclosed and covered by the claim in the patent. Thus,
the controlling fact is that patent protection for the device,
fully disclosed in and covered by the claims of the patent, would
be extended by the allowance of the claims in the application.

Furthermore, there is no apparent reason why applicant was
prevented from presenting the claim in the application for
examination during the prosecution of the issued patent.

EXAMPLE VI

This Example deals with a double patenting situation wherein a function from a means clause is omitted from the claim in issue.

FACT SITUATION

An earlier filed patent specifically discloses a device that conveys pre-sorted mail that is bar coded. The device includes a single means which not only reads the bar code but also sorts the mail according to what the bar code instructs.

The claim in the patent reads as follows:

Patent Claim 1: A device comprising a conveyor in combination with a means for reading a bar code on a conveyed article and for sorting the article according to the instruction in the bar code... .

A latter filed patent application has a claim that reads as follows:

Application Claim 1: A device comprising a conveyor in combination with a means for reading a bar code on a conveyed article.

Claim 1 of the application is the same as Claim 1 of the patent except that Claim 1 of the application has eliminated the additional function of the means. That being the sorting function.

DISCUSSION

Inquiry

- (1) Is the subject matter recited in the claim of the

application fully disclosed in the patent and would the allowance of the claim in the application extend the right to exclude already granted in the patent?

As already stated, the means is fully disclosed. As to the right to exclude already granted being extended, the answer is yes. If allowed the claim of the application would extend the right to exclude already granted by the patent. The means for performing both functions is covered by both patent and application. Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application.

Since the answer is yes, the next question is -

(2) Is there any reason why applicant was prevented from presenting the same claim for examination during the prosecution of the issued patent?

If no - a non-statutory, non-obvious type double patenting rejection is proper.

EXAMPLE VII

This Example deals with an obvious type double patenting situation wherein an element and its function is omitted from the claim in issue.

FACT SITUATION

An earlier filed patent specifically discloses a replacement window comprising a frame, two sliding glass panels and an associated sliding screen panel.

The claim in this earlier filed patent reads as follows:

Patent Claim 1: A replacement window comprising a frame, two sliding glass panels and an associated sliding screen panel.

A later filed patent application has a claim that reads as follows:

Application Claim 1: A replacement window comprising a frame and two sliding glass panels.

This claim was never earlier presented.

DISCUSSION

The only difference between these two claims is that in the later filed case the screen is omitted. Clearly, applicant is attempting to obtain broader coverage in the claim of the application.

When considering whether the invention defined in the claim of an application is an obvious variation of the invention defined in the claims of the patent, the disclosure in the patent may not be used as prior art - only the claim.

Thus, the patent claim is considered as prior art. As

stated above, the only difference between the two claims is that the prior art has the screen and the claim at issue has no screen. The question then becomes - Does the omission of the screen in the patent claim constitute an obvious expedient to one of ordinary skill in the art?

It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. This line of reasoning would be the basis of an obvious type double patenting rejection.

Assume for a moment that the disclosure of the patent in this Example has two embodiments and that there is no apparent reason why applicant was prevented from presenting the claim in the application for examination during the prosecution of the issued patent. One embodiment is the replacement window with the screen and the other embodiment is without the screen. Would a non-statutory, non-obvious type double patenting rejection also apply?

The answer is yes because -

- (1) As already stated, the claim in the application (the embodiment without the screen) was fully disclosed in the patent;
- (2) As to the right to exclude already granted to the patent being extended, the answer is yes. By the use of the

transitional phrase "comprising", the claim of the patent and the claim of the application both cover all of the elements of the replacement window - that is, the frame, the panels and the screen. Thus the controlling fact is that patent protection for the replacement window, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application; and

(3) As already stated, nothing prevented applicant from presenting the claims in the application for examination during the prosecution of the issued patent.

If the patent did not have an embodiment to a replacement window without a screen no non-obvious type double patenting situation would exist.